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STEPHEN C WREN

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EXAMINER

WEINHARDT, R

ART UNIT

PAPER NUMBER

2

2411

DATE MAILED: 09/14/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- Notice of References Cited by Examiner, PTO-892.
- Notice of Art Cited by Applicant, PTO-1449.
- Information on How to Effect Drawing Changes, PTO-1474..
- Notice of Draftsman's Patent Drawing Review, PTO-948.
- Notice of Informal Patent Application, PTO-152.
- _____

Part II SUMMARY OF ACTION

1. Claims 1-5 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-5 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Serial Number: 08/268,309

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for centralizing information about goods and/or services, the means of providing helpful information including means of transmitting information about goods and services, means to remit payment, means for remittance of documents, means to reduce regulatory constraints and video conference means must be shown or the feature cancelled from the claim. No new matter should be entered.
3. The disclosure is objected to because of the following informalities:
Applicant is required to fill in the blank serial number for the related application on page 1 of the instant specification. Appropriate correction is required.
4. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.
The oath or declaration is defective because:

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It does not make a clear claim to priority under 35 USC 120 for the listed related applications.

Also, as this application is a C-I-P, it is defective in that it does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. § 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose material information as defined in 37 C.F.R. § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

5. Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation of "utilizing remote and central locations" is confusing in that a "location" is a position or a site, not hardware or means. Thus, it is not clear how a "location" is utilized to transact business as described. Further, the means for transmitting comprising at least one input means is not clear in that it is not known which "location" the input means is associated with or how a mere "input" means provides transmission. Also, the recited means for establishing communication is confusing in light of the means to establish contact in that establishing contact with the central location appears to include establishing communication between the remote and central "locations". Moreover, the recitation of "using equipment at a remote location" is unclear in that no "equipment" has been positively provided at the remote location for establishing

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contact. In addition, it is not clear if "a remote location" and "a central location" associated with the means to establish contact are the same as or different from "said" remote and central locations recited above. Further, the recitation of "helpful" information is not clear in that it does not positively point out the subject matter covered by the claim. Whether information is "helpful" depends on a subjective interpretation of the viewer and does not indicate structure or content. Also, "the transaction being proposed" lacks clear antecedent basis. Moreover, the means of providing "helpful" information is described as including means of transmitting information about goods and/or services. It is not clear if this means makes use of or is a replacement for the means of centralizing information about goods and/or services or the means for transmitting information between the remote and central "locations". In other words, as the means of providing "helpful" information provides for its own transmission and information, it appears that the previously recited means of centralizing and means for transmitting are redundant.

Claim 1 also recites "wherein said customer is to be charged for the use of said transmitting means". First, this is unclear in that two means for transmitting have been recited and it is not clear which one is being referred to. This recitation is further unclear in that sufficient means have not been established to achieve the desired result of charging the customer. In addition, the recitation of the

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representative providing information about the goods and/or services is not clear in that it appears to make the means of providing information redundant. Finally, it is not clear how utilizing an input device at the remote location relates to the transaction of business or if this input device is the same as or different from the input device previously recited.

In claims 2 and 4-5, it is not clear how the means to remit is associated with the remainder of the system.

In claims 3 and 5, it is not clear how customer supplied information is conveyed when such information has not been generated.

Further in claim 5, it is not clear how communication is provided by "a video conference" as such a "conference" is not means to provide communication. Also, it is not clear what aspect of the "video" the recited attributes relate to. Finally, it is not clear if the video conferencing is part of the recited "list" or if it is a requirement in addition to one of the items on the list.

6. Claim 5 is rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 5 is either misdescriptive or not fully and clearly described in the specification with regard to the "means to reduce regulatory constraints". As the disclosed means do not operate on, modulate or alter the regulatory constraints themselves, it is not clear what is encompassed by this "means to reduce regulatory constraints".

7. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 58-74 of copending application Serial No. 08/264,184 as far as the claims are definite in light of the 35 USC 112 issues raised above. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons noted below.

Claims 58-74 of co-pending application SN 08/264,184 recite a system and method for "facilitating business transactions", but the steps and means recited include reworded versions of the same subject matter save for the intended use of charging the customer for use of the transmission means and the use of a representative at the central location. However, as the claims of the '184 application already include means to remit payment and it is well known for on-line information services such as "bulletin boards" to charge for the use of the system, it would have been obvious to those of ordinary skill in the art to modify the '184

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claims to use the means to remit payment recited therein to charge the customer. With regard to the representative at the central location, initially, note that this is only expressed as an option and is not required by the instant claims. Note the "at least one of the following" language in instant claim 1. Further, the claims of the '184 application clearly recites video conferencing, which implies that some person be present for the customer to have a conference with. As the system and method are provided for facilitating transactions involving goods and services, it would have been obvious to those of ordinary skill in the art that the content of the conference is also for facilitating transactions and well known forms of facilitation include the provision of information on the items sold. As a result, the instant claims represent obvious variants of the claims in the '184 application.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicant is reminded to maintain a clear line of demarkation between applications.

8. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

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9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. Claims 1-5 are rejected under 35 U.S.C. § 103 as being unpatentable over D'Agostino as far as the claims are definite in light of the 35 USC 112 issues mentioned above.

D'Agostino teaches a system for providing information and for completing transactions for financial products or services. The system includes at least one centrally located representative terminal and plural customer terminals located remote from the central terminal. Also included in the system is means for transmitting and receiving information between the remote and central locations, input means at both the central and remote locations to enter information into the terminals, means for storing information concerning the products or service, means at the remote location to establish contact with the central location and means for

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providing information to the customer concerning the transaction for the financial products or services. D'Agostino further teaches that the central terminal, as operated by the representative, controls the operation of the remote terminal, that the remote terminal can accept payment, that the remote terminal can print a document and that voice and video contact is provided between terminals.

While D'Agostino does not specifically teach that the information about the products and services is centralized, D'Agostino does teach that a microcomputer need not be used in the customer terminals and that these terminals can be a single passive display or an intelligent display. As the product information in D'Agostino is stored at the customer terminals in the preferred embodiment, when the a "dumb" terminal is used as suggested by D'Agostino, no means are provided at the customer terminal to provide the required information. As centralized databases are well known, (note the discussion of Lockwood on col. 2 lines 35-54 of D'Agostino), and as D'Agostino also requires that the representative orally provide a general description of each product to the customer, (see col. 13 lines 59-62), it would have been obvious to those of ordinary skill in the art to modify the teachings of D'Agostino to utilize well known centralized product and services databases so as to provide the required information when dumb terminals are used and for the obvious advantage of providing the representatives with the information necessary to make the oral presentations to the customer. As dumb terminals do

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not require the microcomputer or its associated storage peripherals, obviously a cost advantage is provided.

Finally, while D'Agostino does not specifically teach that the "customer is to be charged for the use of said transmitting means", in light of the above 35 USC 112 issues, no means have been specifically provided in the claims to support this intended use. Moreover, as mentioned above, D'Agostino already includes means to remit payment and it is well known for on-line information services such as "bulletin boards" to charge for the use of the system. Thus, it would have been obvious to those of ordinary skill in the art to modify D'Agostino to use the means to remit payment recited therein to charge the customer for such use for the obvious advantage of generating a revenue for the information services supplied.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

King, Jr. et al., Dworkin, Geier et al., Bullock et al. teach electronic catalog and ordering systems. Walker teaches a remote transaction system including a speaker phone. Lee teaches a bidding system including a human operator. Lalonde et al. teach a computerized classified ad system including a human operator. Davis teaches a telecommunication system for telemarketing agents including a display terminal. Tornetta teaches a real estate information presentation system.

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12. It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. A suggested format for a certificate follows.

"I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks, Washington, D.C. 20231, on ..."

Name of applicant, assignee, or Registered Representative

Signature _____

Date _____

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached on (703) 305-9711. Facsimile transmissions to this Group may be directed to (703) 305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

September 8, 1995


ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2400